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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

4386.75743

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Typed or printed
name _____

Application Number

10/590,907

Filed

August 28, 2006

First Named Inventor

Atsushi Tanno

Art Unit

1791

Examiner

Fischer, Justin R.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 41,760

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Joseph P. Fox

Typed or printed name

(312) 360-0080

Telephone number

May 28, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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4386.75743

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Atsushi Tanno
Serial No.:	10/590,907
Conf. No.:	5612
Filed:	08/28/2006
For:	PNEUMATIC TIRE
Art Unit:	1791
Examiner:	Fischer, Justin R.

Pre-Appeal Brief Request for Review


Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests a pre-appeal review of the outstanding final rejections of the pending claims in this Application based upon the attached remarks.

Respectfully submitted,
GREER, BURNS & CRAIN, LTD.

May 28, 2009
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By 
Joseph P. Fox
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Pre-Appeal Brief Request for Review

Remarks

An inadequate examination is demonstrated by the record of this prosecution and, in particular, unsupported misrepresentations of the motivation provided in the prior art that can only be based upon an improper review of the applied prior art and application. No genuine factual dispute is shown in the record. Requirements of the law of obviousness are not met.

Fairness dictates that the rejection be withdrawn and the application allowed without subjecting applicant to the delay and expense of a full appeal.

I. The Application Should be Allowed on Pre-Appeal Because the Examiner has Failed to Make a *Prima Facie* Case of Obviousness.

A *prima facie* case of obviousness can be established when, for example, a suggestion to modify the reference(s) is taught by the reference(s). The Examiner has committed a clear error in examination of this application because the asserted teaching of Tsihlas in the record is lacking in the cited prior art reference. The record shows that the Examiner has inaccurately attributed features to the reference using impermissible hindsight. A statement related to a feature in a reference not supported in the record is clearly an error. An inaccurate interpretation of a prior art reference shows an intentional distortion of the reference to fit the theory of the rejection, which clearly has been pre-ordained during the Examination for the reasons discussed below.

A. *The Examiner's Assertions That Tsihlas Teaches A Height of a Rim Within 2% of A Height of a Gap is Inaccurate Because Tsihlas Teaches Away From Such a Structure.*

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the

reference, or would be lead in a direction divergent from the path that was taken by the applicant...[or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.” (Emphasis added). Tec Air, Inc. v. Denso Manuf. Michigan, Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999) *quoting* In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). Applicants respectfully submit that Tsihla teaches away from a height of a rim being within 2% of a height of a gap when forming a device for attenuating cavity noise in a tire and wheel. The following disclosure of Tsihla exemplifies why Tsihla would not desire to have the difference in heights between a ridge and gap within 2% of each other.

Tsihla teaches in paragraph [01] that the invention relates to devices for attenuating noise generated by rolling tire and wheel assemblies of the type defining a closed interior cavity, for example, pneumatic tire and wheel assemblies. According to the invention of Tsihla, acoustic waves are disturbed in the transmission of energy to the wheel attenuated by a device that provides non-uniformities in the cavity's circumferential direction. Tsihla discloses that the invention is formed of at least one circumferential ring providing a non-continuous profile of alternating ridges and gaps. The at least one ring is located in the tire cavity on the surface of the tire or the wheel. (See paragraph [05]).

Tsihla further teaches that the alternating position of the ridges and gaps provides the improved wave interrupting function as compared to a continuous ring of absorbent material. (See paragraph [08]).

Paragraph [021] of Tsihla teaches that because the tire cavity is substantially uniform in a circumferential direction, a direction into the plane of FIG. 1, the acoustic energy can form so-called standing waves in the air contained in the cavity. Paragraph [022] of Tsihla further discloses that cavity noise can be attenuated by one or more profiled rings mounting in a tire cavity to make the interior space non-uniform in the circumferential direction.

According to the invention of Tsihla, the ring has a non-uniform profile along its length, the length corresponding to a circumferential direction in an entire

cavity. The ring geometry comprises ridges separated by gaps defining a stepped radially outer surface. The ridges and gaps are formed with tire cavity facing surfaces that extend circumferentially between step-like transitions, providing abrupt changes in profile between a ridge and an adjacent gap. The change in the tire cavity circumferential profile as the ring rotates about the standing wave, which disturbs the wave, attenuates the cavity noise. Additionally, the positioning alternately of the ridges and gaps with the peaks at the wave achieves an improved attenuation as compared to a continuous strip. (See paragraph [023] of Tsihlas)).

Paragraph [026] of Tsihlas teaches that a height of the gaps 46 occupies at least half the height of the ridges 42. That is, the base 48 of the strip 42 at the gap 46 is less than half the height of the ridge 44.

FIG. 2 of Tsihlas shows the gaps 46 that are substantially different in height in the radial direction as compared to the ridges 44. FIG. 3 of Tsihlas further illustrates gaps 47 are substantially different in height than ridges 45. Accordingly, Applicants respectfully submit that Tsihlas teaches a device for attenuating cavity noise in a tire and wheel that has a height of the gaps that is substantially different from that of a height of the ridges.

In the Advisory Action of May 1, 2009, the Examiner admits that Tsihlas teaches a preferred embodiment in which a height of the gaps occupies at least half the height of the ridges. However, the Examiner further interprets the Tsihlas reference to teach non-preferred embodiments that encompass all embodiments that do not have a height of the gaps occupying at least half the height of the ridges. This interpretation of Tsihlas by the Examiner is incorrect.

The Examiner has attributed features to Tsihlas that are not disclosed or suggested by Tsihlas. Tsihlas teaches away from forming a height of the gaps to within 2% of the height of the ridges. This is clear based upon the above teaching of the invention of Tsihlas.

In the rejection, the examiner argues that Tsihlas would desire to design the ridges and gaps to have approximately the same length so that the respective parts differ

by 2% or less, as in applicants' Specification. However, the Examiner has not recognized that an artisan would be discouraged from having the height of the gap and ridges differing by 2% or less because this would result in a closed cavity with a substantially uniform portion in a circumferential direction. Thus, the energy waves would not be attenuated since there are not any non-uniformities in the cavity circumferential direction. The prior art does not teach, nor in any way suggest, the height of the gaps that differs from that of the ridges by 2% or less. Instead, the Examiner has used impermissible hindsight to assert that Tsihla teaches the present invention. For at least this reason the rejection is improper, and should be withdrawn.

B. The Examiner Has Provided No Motivation for Modifying the Ridge and Gaps of Tsihla to Have a Height that Differs by 2% or Less.

A *prima facie* of obviousness can be established when, for example, a suggestion to modify the reference(s) is taught by the reference(s). The Examiner has committed a clear error in examination of this application because there is no motivation to modify the height of the gaps such that they are within 2% of the height of the ridges nor has the examiner supported the rejection on any of the other proper rationales for supporting a conclusion of obviousness. *See* MPEP §2143.

The Examiner acknowledges that Tsihla prefers to have the heights of the gaps occupying at least half of the height of the ridges. In the May 1, 2009 Advisory Action, the examiner asserts that because Tsihla teaches such a preferred embodiment, then heights in which the gaps occupy less than half the heights of the ridges would correspond to all non-preferred embodiments. This interpretation of the references is too broad because it encompasses every conceived variation in heights between the ridges and gaps. Nonetheless, assuming *arguendo* that the Examiner is correct, the Examiner has still provided no motivation why these non-preferred embodiments would encompass the height of the gap that differs by 2% or less of the height of the ridge.

The Examiner is using impermissible hindsight to assert that such embodiments are suggested by Tsihlas. However, as discussed above, Tsihlas clearly requires that there be a substantial difference between heights of the ridges and gaps so that the sound waves within the tire can be attenuated. Tsihlas specifically teaches that a continuous layer without any ridges and gaps results in a standing wave being formed within the tire. Thus, the examiner incorrectly interpreted the disclosure of Tsihlas when asserting that non-preferred embodiments would encompass designs wherein the ridges and heights have a height that differs by 2% or less.

Since the Examiner has not provided any proper motivation for modifying Tsihlas such that the difference between the height of the ridges and gaps is 2% or less, the obviousness rejection is in clear error and should be withdrawn.

II. Conclusion

Applicant asks that this pre-appeal review request be sustained, and the application allowed. As no sufficient rejections have been established, the pendency of this application should be ended with issuance of Notice of Allowance.

Respectfully submitted,

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By


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May 28, 2009
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